

Remarks

Claims 1-14 and 16-46 are pending in the application. Claim 15 has been cancelled.

Double Patenting Rejections

On page 3 in paragraph 2 the Examiner rejected claims 1-3, 6, and 10-13 on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 8-9 of U.S. Patent No. 7,206,814 B2. In response, Applicant is submitting with this Response a terminal disclaimer. The appropriate fee as set forth in 37 C.F.R. §1.20(d) is submitted with this Response and Amendment. Applicant therefore requests that the Examiner withdraw the double patenting rejection.

Claim Objections

On page 8 in paragraph 3 the Examiner objected to claims 4, 35, and 38, under 37 C.F.R. §1.75(c), as being in improper form for depending on future numbered claims 44, 46, and 44 respectively. Applicant respectfully traverses.

Applicant's Response filed November 21, 2007 introduced new claims 44-46 and amended claims 4, 35, and 38 to depend from claims 44, 46, and 44 respectively. The Examiner cites MPEP §608.01(n). Paragraph IV of that section states: "During prosecution, the order of claims may change and be in conflict with the requirement that dependent claims refer to a preceding claim." Therefore, Applicant respectfully submits that claims 4, 35, and 38 are in proper form and requests that the Examiner withdraw the objection.

Rejections under 35 U.S.C. §112

On page 8 in paragraph 5 the Examiner rejected claims 10-13, under 35 U.S.C. §112, stating there is insufficient antecedent basis for the limitation “in the spam folder.” In response Applicant is amending claims 10-13, 19, and 20 to recite “in a spam folder.” Applicant therefore requests that the Examiner withdraw the rejections to claims 10-13 under 35 U.S.C. §112.

Rejections under 35 U.S.C. §102(e)

On page 9 in paragraph 7 the Examiner rejected claims 1-14, 16, 18-27, 29-33, 35-39, 41, and 43-46 under 35 U.S.C. §102(e) as being anticipated by Goldman (“*Goldman*”) (US 20030233418 A1). Applicant respectfully traverses and in response, asserts that claims 1-14, 16, 18-27, 29-33, 35-39, 41, and 43-46 are not anticipated by *Goldman*. In order to anticipate a claim, a reference must teach all elements of a claim. See Verdegaal Bros., Inc. v. Union Oil Co., 814 F.2d 628, 631 (Fed. Cir. 1987). In addition, the reference must show the claimed invention “in as complete detail as is contained in the patent claim” in order to anticipate the claimed invention. Richardson v. Suzuki Motor Co., Ltd., 868 F.2d 1226, 1236 (Fed. Cir. 1989). Applicant will show that *Goldman* fails to teach all elements of Applicant’s independent claim 1. Therefore, claims 1-14, 16, 18-27, 29-33, 35-39, 41, and 43-46 are not anticipated and are thus novel.

On page 9 in paragraph 8 the Examiner stated “Goldman discloses . . . the received information including an *actual sender* of the e-mail message (page 3, paragraph 0038).” (Emphasis added.) Applicant’s independent claim 1 recites, *inter alia*, “the received information including at least one of the following . . . *an actual sender* of the e-mail message.” (Emphasis added.) Applicant’s independent claim 1 differentiates

between the sender and an actual sender. Applicant's specification in paragraph [0011] defines the "actual" sender.

the sender which is contained in the message is used to identify the actual sender by a signature either combining pieces of information from the message header or combining a range of IP addresses and information from the message header. Other ways of identifying the sender include using the final IP address used by the sender, the final domain name used by the sender, and/or the IP path used to send the message.

Goldman, in contrast teaches "[an] incoming electronic message . . . may or may not include a sender's address." (See *Goldman* paragraph [0038]). *Goldman* also teaches "the term '**sender's address**' refers to an address that accompanies an incoming electronic message . . . regardless of whether the addresses actually identify the sender." (See *Goldman* paragraph [0046]. Emphasis added.)

The "sender's address" taught by *Goldman* is equivalent to Applicant's "e-mail address used by the sender," which as *Goldman* admits, may or may not identify the sender. Applicant's "actual sender" uses "an e-mail address used by the sender" as only one of many criteria used to identify the "actual sender." *Goldman's* teaching of the use of a sender's address "regardless of whether the addresses actually identify the sender" is clearly not taking steps to improve the likelihood of identifying an actual sender. Thus, since *Goldman* does not teach "an actual sender," *Goldman* does not teach all elements of Applicant's independent claim 1.

On page 9 in paragraph 8 the Examiner stated, "Goldman discloses . . . storing the information (page 3, paragraph 0038: **the incoming electronic message** is stored at a mailbox 20 of the data storage device 19." (Emphasis added.) In particular, *Goldman* teaches "[w]hen **an incoming electronic message** 38 is received at the user's computer 12, the incoming electronic message **is stored at a mailbox 20.**" (See *Goldman* at paragraph [0038]. Emphasis added.) In contrast, Applicant's

independent claim 1 recites, *inter alia*, “**information including at least one of the following . . . an actual sender of the e-mail message . . . a final IP address used by the sender . . . a final domain name used by the sender . . . an IP path used by the sender . . . storing the information.**” (Emphasis added.) Goldman does *not* teach storing information including at least one of “an actual sender of the e-mail message,” or “a final IP address used by the sender,” or “a final domain name used by the sender,” or “an IP path used by the sender.” *Goldman* therefore does not teach all elements of Applicant’s independent claim 1.

On page 9 in paragraph 8 the Examiner stated “Goldman discloses . . . **calculating statistics based on the stored information** (page 1 paragraph 0008).” More particularly, *Goldman* teaches a “data structure 18 that has fields in which **sender’s addresses are categorized**. Each sender’s address is generally separated into one of three categories. The ‘authorized’ category The ‘unauthorized’ category. . . . The ‘unconfirmed category’.” (See *Goldman* at paragraph [0044]. Emphasis added.) Goldman further teaches

“[f]ilter module 24 **compares a sender’s address** associated with an incoming electronic message **to the categorizations** provided or stored in data structure 18 . . . [where] . . . If the sender’s address is located in the authorized category, the filter module 24 routes the incoming message to the user’s inbox 28. If the sender’s address is located in the unauthorized category, the filter module 24 routes the incoming message to the trash box 31. If the sender’s address is located in the unconfirmed category, the filter module 24 routes the incoming message to an unconfirmed folder 69.” (See *Goldman* at paragraph [0049]. Emphasis added.)

Meanwhile, Applicant’s independent claim 1 recites, *inter alia*, “**information including at least one of the following . . . an actual sender of the e-mail**

message . . . a final IP address used by the sender
. . . a final domain name used by the sender . . . an
IP path used by the sender . . . storing the
information . . . ***calculating statistics based on
the stored information.***” (Emphasis added.)

Applicant will show that the categorization and comparing of sender’s addresses as taught by *Goldman* is not “calculating statistics.”

“[A] judge who encounters a claim term while reading a patent might consult a general purpose or specialized dictionary to begin to understand the meaning of the term, before reviewing the remainder of the patent to determine how the patentee has used the term.” *Phillips v. AWH Corp.*, 415 F.3d 1303,1324 (Fed. Cir. 2005).

Accordingly, definitions for the terms statistics, calculate, compare, and categorize appear below.

Statistics

A Glossary of Statistics at

<http://linkage.rockefeller.edu/wli/glossary/stat.html#s>

defines a statistic as “[a] ***number*** or code ***derived by*** a prior-defined consistent process of ***calculation, from a set of data.***” (Emphasis added.)

An on-line glossary of statistical terms, produced by the STEPS TLTP Project at

http://www.stats.gla.ac.uk/steps/glossary/basic_definitions.html#stat defines a statistic as “a ***quantity that is calculated from a sample of data.***” (Emphasis added.)

Calculate

The on-line Merriam Webster Dictionary at

[http://www.merriam-](http://www.merriam-webster.com/dictionary/calculate)

[webster.com/dictionary/calculate](http://www.merriam-webster.com/dictionary/calculate) defines calculate as “to ***determine by mathematical processes.***” (Emphasis added.)

The on-line Encarta Dictionary at

http://encarta.msn.com/dictionary_/calculate.html defines calculate as to “***work something out mathematically.***” (Emphasis added.)

Compare

The on-line Merriam Webster Dictionary at

[http://www.merriam-](http://www.merriam-webster.com/dictionary/compare)

[webster.com/dictionary/compare](http://www.merriam-webster.com/dictionary/compare) defines compare as “to ***represent as similar.***” (Emphasis added.)

The on-line Encarta Dictionary at

http://encarta.msn.com/dictionary_/compare.html
defines compare as to “*examine people or things for similarities.*” (Emphasis added.)

Categorize

The on-line Merriam Webster Dictionary at <http://www.merriam-webster.com/dictionary/categorize> defines categorize as “*to put into a category : classify.*” (Emphasis added.)

The on-line Encarta Dictionary at http://encarta.msn.com/dictionary_/categorize.html defines categorize as to “put somebody or something into category: *to place somebody or something in a particular category and define or judge the person or thing accordingly.*” (Emphasis added.)

As for the alleged statistics of *Goldman*, *Goldman* teaches the storing of senders’ addresses into categories. Senders’ addresses are merely text strings. Senders’ addresses are neither numbers nor are they derived from a process of calculation from a sample or a set of data. *Goldman’s* senders’ addresses are not statistics; they are merely lists of text strings. Therefore, *Goldman* does not teach “calculating *statistics* based on the stored information” as recited by Applicant’s independent claim 1. Therefore, again, *Goldman* fails to teach all elements of Applicant’s independent claim 1.

As for *Goldman’s* calculating, *Goldman* only teaches separating senders’ addresses into categories; separation and categorization are just an arranging of the senders’ addresses into lists, not calculation requiring mathematical processes. A sender’s address is either in a category or not in a category. Further, *Goldman’s* comparing is simply determining into which of the three categories the sender’s address has been sorted. Since *Goldman* just teaches the use of a comparison and categories, and not calculating, or mathematical techniques, *Goldman* does not teach “*calculating* statistics based on the stored information” as recited by

Applicant's independent claim 1. Therefore, *Goldman* once again fails to teach all elements of Applicant's independent claim 1.

On page 9 in paragraph 8 the Examiner stated "Goldman discloses . . . using the ***calculated statistics*** to determine whether the received e-mail is unsolicited e-mail." (Emphasis added.) As shown above, *Goldman* does not teach "calculated statistics" but instead teaches categorization and comparison of categories. Therefore, *Goldman* cannot be said to be "***using the calculated statistics*** to determine whether the received e-mail is unsolicited e-mail." Hence, once again, *Goldman* fails to teach all elements of Applicant's independent claim 1.

On page 9 in paragraph 8 the Examiner stated "Goldman discloses . . . setting a ***predetermined threshold for accepting messages based on statistics associated with an actual sender*** (page 1, paragraph 0010)." (Emphasis added.) Specifically, *Goldman* teaches "[t]he ***periodic recategorization module reevaluates the*** category of sender's addresses that have been previously categorized." (See *Goldman* at paragraph [0010]. Emphasis added.) *Goldman* also teaches "a ***periodic recategorization module*** associated with the electronic messaging management application 11, ***at predetermined intervals*** (or at times requested by the recipient), reevaluates the category in which the sender's address should be identified." (See *Goldman* at paragraph [0081]. Emphasis added.) Thus, *Goldman* merely teaches the use of a ***predetermined time interval*** to decide whether a sender's address should remain in its category or be reassigned to a different category.

In contrast, Applicant's independent claim 1 recites, *inter alia*, "setting a ***predetermined threshold for accepting messages based on statistics associated with one of the following . . . an actual sender . . . a final IP address . . . a final domain name . . . or . . . an IP path.***" (Emphasis added.) *Goldman* does not teach applying a ***threshold*** value

to **statistics** in order to make a determination regarding acceptance of e-mail messages.

As for *Goldman's* alleged teaching of "accepting messages **based on statistics**," Applicant has shown above that *Goldman* does not teach statistics. Hence, *Goldman* is not "accepting messages based on statistics." As for *Goldman's* alleged teaching of "accepting message[s] based on statistics associated with **an actual sender**," Applicant has shown above that *Goldman* does teach an actual sender. Thus, *Goldman* is not "accepting message[s] based on statistics associated with an actual sender." Again, *Goldman* fails to teach all elements of Applicant's independent claim 1.

As Applicant has shown, *Goldman* teaches none of Applicant's independent claim 1 elements relating to 1) an actual sender, 2) storing information, 3) calculating statistics, 4) using the calculated statistics to determine whether the received e-mail message is unsolicited, or 5) a predetermined threshold for accepting messages based on statistics associated with an actual sender. *Goldman* therefore cannot and does not anticipate Applicant's independent claim 1 and thus claim 1 must be allowable. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of claim 1 under 35 U.S.C. §102(e). Moreover, since claims 2-14, 16, 18-27, 29-33, 35-39, 41, and 43-46 depend from claim 1 they too are allowable for at least the same reasons. Further, each of the dependent claims 2-14, 16, 18-27, 29-33, 35-39, 41, and 43-46 are also patentable for its own limitations.

Allowable Subject Matter

On page 17 in paragraph 45 the Examiner objected to claims 17, 28, 34, 40, and 42 as being dependent upon a rejected base claim but stated that they would be allowable if rewritten in independent form including

all of the limitations of the base claim and any intervening claims. Applicant has shown that independent claim 1, from which claims 17, 28, 34, 40, and 42 depend, is not anticipated and is allowable. Therefore dependent claims 17, 28, 34, 40, and 42 should also be allowed. Further, each of the dependent claims 17, 28, 34, 40, and 42 are also patentable for its own limitations and/or features.

Conclusion

Applicant is filing a terminal disclaimer to obviate the double patenting rejection. Applicant shows that claims 44-46 are correctly numbered and the Examiner may renumber the claims when the application is ready for allowance so that claims 4, 35, and 38 will be in proper form and not depend on higher-numbered claims. Applicant is amending claims 10-13, 19, and 20 to cure the antecedent rejections under 35 U.S.C. §112. Applicant shows that independent claim 1 is not anticipated by the cited reference. Moreover, since claims 2-14, 16, 18-27, 29-33, 35-39, 41, and 43-46 depend either directly or indirectly from claim 1, they too are allowable for at least the same reasons. Since independent claim 1 is allowable and not a rejected base claim, dependent claims 17, 28, 34, 40, and 42 should not be objected to and should also be allowed. Reconsideration and a Notice of Allowance are requested

The Examiner is invited to contact the undersigned with any comments or questions at 408-297-9733 between 9:00 AM and 5:00 PM PST.

CERTIFICATE OF TRANSMISSION

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being transmitted via the Office electronic filing system in accordance with § 1.6(a)(4) on the date shown below.

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Respectfully submitted,



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